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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/932,279	08/17/2001	Donald P. Naki	GC626-3	3101
5100	7590	01/16/2004	EXAMINER	
GENENCOR INTERNATIONAL, INC. ATTENTION: LEGAL DEPARTMENT 925 PAGE MILL ROAD PALO ALTO, CA 94304			MARSCHEL, ARDIN H	
			ART UNIT	PAPER NUMBER
			1631	

DATE MAILED: 01/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/932,279	NAKI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Ardin Marschel	1631	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 October 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-94 is/are pending in the application.
- 4a) Of the above claim(s) 30-36 and 77-83 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29, 37-76, & 84-94 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-94 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) <u>2000-03-03 (3 sheets)</u> | 6) <input checked="" type="checkbox"/> Other: Attachment for PTO-948.       |

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### **DETAILED ACTION**

Applicants' election of Group I (claims 1-29, 37-76, and 84-94) in the Paper filed 10/30/03 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

### **DRAWING OBJECTIONS**

Applicants are hereby notified that the required timing for the correction of drawings has changed. See the last 6 lines on the sheet which is attached entitled "Attachment for PTO-948 (Rev. 03/01 or earlier)". It is noted that a PTO Form 948 is mailed herewith. Due to the above notification Applicants are required to submit drawing corrections within the time period set for responding to this Office action. Failure to respond to this requirement may result in abandonment of the instant application or a notice of a failure to fully respond to this Office action.

### **RESTRICTION ELECTION**

Applicant's election of Group I (claims 1-29, 37-76, and 84-94) in the Paper filed 10/30/03. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

### **TITLE**

The title of the invention is not descriptive of the elected specie. A new title is required that is clearly indicative of the invention to which the claims are directed.

### **VAGUENESS AND INDEFINITENESS**

Claims 1-29, 37-76, and 84-94 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 cites the detection of a polymer in the first line. In lines 3-8 of claim 1 the determination of a mass doublet is cited wherein the doublet data is generated via first and second versions of the polymer. One reasonable interpretation is that these first and second versions are different polymers due to the mass difference between them thus conflicting with the preamble as to what is meant for the claim practice. Another reasonable interpretation is that some characteristic of a polymer is being utilized as the identifying characteristic thereof independent of the first and second isotopes cited in the claim. This second interpretation is also unclear in that there is no such independent characteristic cited in the claim. Thus, it is unclear whether firstly the preamble or the steps in lines 3-8 control the metes and bounds of the claim regarding polymer detection vs. different polymer detection, and, secondly, what unrecited characteristic of the polymer being detected is meant for the claim practice. Both of these unclarities result in the claim being vague and indefinite. Claims which depend directly or indirectly from claim 1 also contain these unclarities due to their dependence. Clarification via clearer claim wording is requested.

Claims 1 and 48 lacks any actual polymer detection limitations in lines 3-8 and 5-10, respectively. Thus, they are unclear due to this issue whether the preamble or the steps in lines 3-8 or 5-10, respectively, control the metes and bounds of the claim.

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Claims which depend directly or indirectly from claims 1 or 48 also contain this unclarity due to their dependence. Clarification via clearer claim wording is requested.

Claims 37 and 84 lack any actual polymer detection limitations in lines 4-26 and 5-27, respectively, but rather only recites fragment detection. Thus, claims 37 and 84 are unclear due to this issue whether the preamble or the steps in lines 4-26 or 5-27, respectively, control the metes and bounds of the claim. Claims which depend directly or indirectly from claims 37 or 84 also contain this unclarity due to their dependence. Clarification via clearer claim wording is requested.

#### **PRIOR ART**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-16, 18-29, 37, 38, 41, 44-63, 65-76, 84, 85, 88, and 91-93 are rejected under 35 U.S.C. 102(e)(2) as being clearly anticipated by Geysen et al. (P/N 6,475,807).

In the abstract of Geysen et al. the invention therein is directed to mass spectrometry analysis of isotopically labeled constructs which is also the instantly claimed subject matter. The SUMMARY OF THE INVENTION section in columns 5-8 also disclose the isotopic determination (detection as instantly claimed) of isotopically

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labeled combinatorial library products. Polymers of amino acids are isotopically labeled and detected as summarized in EXAMPLE 18 in columns 51-56 of the reference specifically with doublet mass detection disclosed in column 53, line 28, through column 56, line 11, as is the final determination cited also in instant claim 1. The computer implementation of the method as also required in instant claim 1, line 2, is shown as a computer program in Figure 287 of the reference and described in column 5, lines 60-63. Various polymers that are detectable as disclosed in the reference in column 6, lines 48-60, as also claimed instantly in claim 4 directed to nucleic acid/nucleotide polymers. Possible isotopically labeled atoms as in instant claims 10-13 are cited in the reference in column 8, lines 28-35, and column 12, lines 8-20, and column 25, lines 45-47. Multiple scans of isotopic determinations are set forth in the numerous Figures of the reference as required in instant claim 18.

#### **INFORMATION DISCLOSURE STATEMENT**

Several citations were lined through on the enclosed PTO Forms 1449 due to lacking a date of publication as required for citations of such Forms.

No claim is allowed.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the Central PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CFR § 1.6(d)). The Central PTO Fax Center number is (703) 872-9306.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is

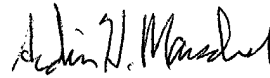
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(703)308-3894. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703)308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instrument Examiner, Tina Plunkett, whose telephone number is (703)305-3524 or to the Technical Center receptionist whose telephone number is (703) 308-0196.

January 9, 2004

  
ARDIN H. MARSCHEL  
PRIMARY EXAMINER